

III. Remarks

Election of Species: First, the Applicant would affirm the provisional election (made by Applicant's representative, Al Wiedmann Jr., via telephone on September 8, 2008) of Group I (claims 1-22, which are all apparatus claims as originally filed), and Species I (Figs. 1, 3, 5 and 6) of Group I. Relative to the claims as originally filed (i.e., as they appear before the entry of the claim amendments filed herewith), claims readable on Species I include claims 1-6, 8-18, 20, 21 and 42. Relative to claims as amended herein, the claims readable on species I are 1-4, 8-13, and 20-22. Claims not directed to Species I have either been canceled or withdrawn (several of the originally filed claims readable on Species I have been canceled, but for reasons other than the species restriction). The Applicant would indicate that amendments have been made herein to claims of unelected Group II (method claims) so as to track those amendments made herein to elected Group I (apparatus claims), thereby preserving the right to rejoinder. Claim 1 is believed generic to both species; upon its allowance, the Applicant would request rejoinder of unelected claims of Species II. The Applicant would also indicate that withdrawn independent claim 23 of unelected Group II, as amended herein, requires all of the limitations of independent claim 1; as such, rejoinder of claim 1 and dependents upon allowance of claim 1 and dependents is believed appropriate.

Drawings: The examiner expressed concern relative to the drawings, requesting new drawings be prepared. In response to the drawing concerns expressed by the examiner, the Applicant has filed formal drawings herewith and asks that the drawings of Exhibit A, which is incorporated herein as part of this response, replace the originally filed drawings. The Examiner first expressed concern because the drawings as initially submitted were informal. The examiner also expressed concern relative to the use of brackets. The Applicant, in response, has formalized all drawings and changed the brackets to diverging lines (which still refer to the same components or parts). In this regard, the Applicant would respectfully point out that there is no prohibition against the use of brackets in the drawing rules promulgated relative to patent applications; the examiner's preferred use of lead lines with arrows is believed not to indicate the

parts/components that the numbered element is referring to as clearly as would a bracket or the diverging lines used herein. The solid black shading has been changed to gray shading. Reference character “22” now has solid lead lines (it is not the case that the lines are not visible due to obstruction). The box appearing as a margin for each figure has been deleted. Cross-hatching has been added to Figure 3. The tubes in Figure 6 are no longer shown in phantom.

The Examiner’s concerns relative to Figure 3 are justified; indeed, reference character 29 was incorrectly pointing to the larger tube instead of the clearance that 29 represents. It now points to the clearance, which is just “outside” of the upper portion of the tube. It is of note that the white rectangular section that 29 used to point to (before these drawing changes) is in fact a part of the larger tube that is above the holes 21 through which the projections 20 pass; the vertical cut resulting in this cross-section is made through the holes that appear in the larger tube, thereby giving the illusion that the upper portion of the larger tube is disconnected from the lower portion. It is also of note that the specification has been amended to correct the number used for the projection from 21 to 20 (the correct use of terms 20 (a projection such as a post) and 21 (a hole) is found in Fig. 1 as originally filed).

In response to the examiner’s concerns relative to reference characters “3” and “16” both referring to the same part in Figure 2, the Applicant would first indicate that 3 is the compression enhancement element and 16 is a clamp, and because a clamp is a type of compression enhancement element, such usage should be acceptable. Nevertheless, the Applicant has amended Fig. 2 to remove the objectionable use of the character “3”. As to the examiner’s concerns relative to the use of “13” and “14” as referring to the same part in Fig. 2, the Applicant would point out that this should be acceptable because 13 and 14 refer to different axes that happen to overlap in embodiment of Fig. 2. The Examiner has also expressed concern relative to the use of reference character “4” and its use in Fig. 2 to designate both a projection and a recess. However, 4 is a relative motion obstruction element, and in the embodiment of Fig. 2, has two parts (a projection and a

recess (e.g., a hole)). Further, the specification as originally filed (with the above-mentioned correction to change 21 to 20) indicates that:

It should be noted that the term element as used in this application may describe not only one part or structure, but also a plurality of parts or structures (20) e.g., that make up a device. As such, in at least one embodiment of the inventive technology, the relative motion obstruction element may include at least one projection (21) (e.g., a post, which may have any cross-sectional shape and which may project inwardly from the compression sleeve element), and at least one recess (e.g. a hole) sized to receive the post, thereby preventing axial and rotational motion.

Page 5, lines 4-10 of the specification. Note that 4 is a relative motion obstruction element. The same applies regarding the Examiner's concern as to the use of reference character "3" of Fig. 7; "3" is a compression enhancement element and more than one part can make up such element, even in one embodiment.

Concerns Relative to the Specification:

The Examiner expressed concern relative to the Abstract. In response, the Applicant has amended the Abstract. The Examiner expressed concern relative to the use of reference character "(25)"; in response, the Applicant has amended the application to remove the reference character "(25)" from it. However, in response to the examiner's concerns relative to the use of the character "(1&)", the Applicant would point out that such amendments were made in an Article 34 Amendment filed on February 16, 2006, and later forwarded alongside all other US national phase filing documents on July 14, 2006.

Claim Objections:

The Examiner expressed concern relative to the use of the term "it" in line 12 of claim 1, and relative to the use of the term "compression" in line 18 of claim 1. In response, the Applicant has replaced the term "it" with "levered clamp" and indicates that

the text of claim 1 with the concerning use of the term “compression” has been amended. The Examiner’s concerns relative to claim 18 have been resolved through the cancellation of claim 18. The Examiner’s concern relative to the use of the term “characteristic” in claim 14 has been resolved through the cancellation of claim 14.

Concerns Relative to the Claims Under 35 USC §112:

The Examiner expressed concern relative to whether the first elongated member and the larger elongated member are part of the apparatus of claim 1. In response, the Applicant indicates that all limitations of claim 1 as originally filed which the examiner believes suggest that the elongated members are part of the claimed apparatus (to wit, lines 9-11 and 22-24, which state - “wherein said third portion of said first elongated member has a first longitudinal axis and said at least a fourth portion of said larger elongated member has a second longitudinal axis” and “wherein said third portion of said first elongated member and said at least a fourth portion of said larger elongated member are substantially coaxial, wherein said at least a fourth portion of said larger elongated member is hollow”) have been canceled from claim 1 in the amendments filed herewith. Nonetheless, some text now appearing in claim 1: “An ... apparatus comprising: ... a relative motion obstruction element adapted to prevent axial and rotational motion of said compression sleeve element relative to said larger elongated member, said relative motion obstruction element itself having at least one hole established in said larger elongated member” does indicate that a hole established through the larger elongated member is indeed a limitation of claim 1. Thus, the members themselves are not part of claim 1 (meaning that they are not explicit limitations therein; of course, an apparatus having such members could not escape infringement simply because of the presence of such members). This is in keeping with the “retrofitability” of certain embodiments of the apparatus of claim 1. However, a dependent claim (such as claim 21) certainly could incorporate the members as explicit limitations of the claimed apparatus.

In response to the Examiner’s concerns relative to claim 14, the Applicant has canceled claim 14.

In response to the Examiner's concerns relative to claims 15-18, the Applicant has canceled claims 15 - 18. The Applicant is of the opinion, however, that indeed functional limitations can, even in apparatus claims, lend patentable distinction to a claim relative to prior art. Such claim cancellations have also rendered the Examiner's concerns relative to claims 16, 17 and 18 moot.

Relative to the Examiner's concerns regarding claim 21, the Applicant would state that, as noted above, the hole passing through the larger elongated member is indeed a part of claim 1, but the elongated members are not explicitly limitations of claim 1. Claim 21 serves to make such elongated members limitations of the claimed apparatus.

The examiner expressed indefiniteness concerns relative to claims 2-6, 8-13 and 20, stating that they are indefinite because their base claim - claim 1 - is indefinite. The Applicant would point out that because claim 1 is now no longer indefinite, it can not be said that claims that depend from it are therefore indefinite also.

35 USC §102 Concerns:

Hampel: The Examiner expressed concern relative to claim 1 and certain dependents as based on a patent issued to Hampel (US 4,397,088; hereinafter referred to as Hampel). In response, the Applicant would point out that claim 1 has been amended, and that the Hampel reference simply does not disclose all the limitations of claim 1 as it must if it is to serve as a valid §102 reference. The Hampel reference does not disclose the following limitations of claim 1: (1) "a levered clamp"; (2) "a levered clamp operable to generate a compressive force that retains said first elongated member in a desired fixed position relative to said larger elongated member"; and (3) "a levered clamp that forces ... said at least one projection against a surface of said at least one third portion of said first elongated member." As to undisclosed limitation (1), Hampel certainly does not show a levered clamp. As to undisclosed limitation (3), nothing in Hampel forces a projection against a surface of the first elongated member. Instead, in Hampel, it is clear

that the lugs 46 (analogous to the projections of claim 1) extend through holes of the larger tube only to then pass through holes of the smaller tube - in other words, such lugs are not forced “against a surface” of the first elongated member at all. This feature of Hampel - where the lugs are forced through holes of the smaller, nested tube - is a reason why Hampel does not disclose undisclosed limitation (2). Simply, there is only one relative position in which the tubes of Hampel can be retained and, as such, Hampel does not disclose anything (much less a clamp) that is operable to “generate a compressive force that retains said first elongated member in a *desired* fixed position relative to said larger elongated member.” Of course, and as is clear from the specification, a desired fixed position is that single one position preferred by a user over all of the other many possible positions. Hampel allows the retention of the tubes in only one relative position; Hampel is intended merely to provide breakdown for storage/shipping and secure (but not adjustable as desired) reassembly. Because claim 1 is novel relative to Hampel, so too are all claims that depend from it.

Liao: The Examiner also expressed novelty concerns as based on a patent issued to Liao (US Pat. No. 5,738,326; hereinafter referred to as Liao). In response, the Applicant would again point out that claim 1 has been amended, and that the Liao reference simply does not disclose all the limitations of claim 1 as it must if it is to serve as a valid §102 reference. The Liao reference, at the very least, does not disclose: (1) “at least one projection projecting inwardly from said compression sleeve element and through said at least one hole” (claim 1 requires that such hole be “established in said larger elongated member”); and (2) “a levered clamp that forces ... said at least one projection against a surface of said at least one third portion of said first elongated member” (claim 1 defines the third portion of said first elongated member as being that portion that is nested in the larger elongated member). As to undisclosed limitation (1), it first must be determined which of the three members (tubular or elongated) of the Liao apparatus are analogous to the first elongated member and the larger elongated member of claim 1. Claim 1 makes clear that portions of the first and the larger elongated members are surrounded by the compression sleeve; as such, because the part in Liao most analogous to the compression sleeve of claim 1 is part 31, and because such part

surrounds portions of only members 22 and 201 (and not of the lower member 20) of Liao, such parts (22 and 201) are the most analogous to the first and larger elongated members of claim 1, respectively (note that the “sleeve” of Liao, when established in retention mode, sits on 20 instead of surrounding it). As such, the examiner, respectfully, appears to be incorrect in relying on 211 of Liao to serve as disclosure of the hole of claim 1 (simply, the hole of claim 1 is through the *larger* elongated member and, as explained, because 20 (the lowest tube or elongated member of Liao) is not surrounded by the “sleeve” 31, 20 cannot be the “larger elongated member”). The only member in Liao that might be properly viewed as most analogous to the larger elongated member of claim 1 is 201, and, again, there is no hole through 201. As to undisclosed limitation (2), it must again be considered which of the tubular or elongated members of Liao might be properly viewed as analogous to the first and the larger elongated members of claim 1. Again, for the reasons given above, parts 22 and 201 of Liao are the most analogous to the first and larger elongated members of claim 1. As such, Liao does not disclose “a levered clamp that forces ... said at least one projection against a surface of said at least one third portion of said first elongated member”, where the “projection project[s] inwardly from said compression sleeve element and through said at least one hole.” Again, parts 40 and 211 at first glance might seem analogous to the projection and hole of claim 1, but 40 of Liao is not forced through 211 so that it contacts 22 (the part that is most correctly viewed as the first elongated member). It is of note that there may be other reasons why the Liao reference does not disclose the claimed subject matter. Because claim 1 is novel relative to Liao, so too are all claims that depend from it.

Concerns Under 35 USC 103:

Claim 8: The Examiner expressed concern relative to claim 8 under 35 USC §103 as based on Hampel in view of a patent issued to Chen (US Pat. No. 6,557,878; hereinafter referred to as Chen). Of course, as the Examiner is well aware, in order to support a *prima facie* case of obviousness, references relied upon must disclose all limitations of the claim. Chen does appear to disclose a levered clamp with an eccentric cam, but, of course, claim 8, in depending from claim 1, includes all of the limitations of

claim 1 and, as explained above, Hampel does not disclose “a levered clamp that forces ... said at least one projection against a surface of said at least one third portion of said first elongated member” (again, a limitation of claim 1 and, therefore, claim 8). In relevant regard, it is of note that in claim 1, such third portion of the first elongated member is nested within the larger elongated member, the projection projects inwardly from the sleeve, through a hole in the larger elongated member, and is forced against the surface of the “nested” third portion. However, in Chen, what appears to be a “sleeve” doesn’t even surround the larger tube 10 (instead, it is inserted into it; see col. 2, lines 30-33 of Chen), and as such, nothing could project inwardly from the sleeve through a hole in the larger member to contact a portion of the smaller tube that is nested within the larger tube.

Claim 18: Claim 18 has been canceled.

Comment Relative to Claim Amendments and Support Therefore: It is of note that the amendments to the claims are not believed to constitute new matter. Support for the amendments is found throughout the application, for example, in the figures (see in particular, Figs. 1 and 3), and in the description (see, e.g., pages 4, l. 34 – page 5, line 12).

IV. Conclusion

In response to the Examiner's concerns, the Applicant has amended the claims and the specification. Claims 1-4, 8-13, 19-23, 30 and 31 have been amended, claim 42 has been added, claims 5-7, 14-18, 24-29 and 32-41 have been canceled, and claims 19, 23, 30 and 31 have been withdrawn. It is believed that all pending claims are in condition for allowance. It is requested that the Examiner please reconsider the application and allow the claims at his earliest convenience.

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Respectfully Submitted:

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SECTION V

EXHIBIT A – REPLACEMENT SHEETS